

### REMARKS

Claims 1, 3-5 are pending and under consideration in the application. Claims 2, 6, 7, 8, 10-14 were previously canceled. Claims 15 - 46 were withdrawn.

In the present amendment, claims 1 and 3-5 were amended to better point out and distinctly claim the subject matter of the present application. No new matter has been added.

Applicant further argues that the Advisory Action is improper. Examiner argued in prior action that product-by-process language was not examined but now argues that the changes made to the claims to remove the unexamined matter (product-by-process language) somehow requires a new search. This argument does not follow logically. Applicant requests return of all fees associated with this response and a proper response to the Applicant's prior response to the Office.

#### Rejections under 35 U.S.C. § 112

Claims 1, 3-5 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. MPEP § 2173.02. The Office's focus must be on whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. MPEP § 2173.02.

The Office states that claims 1 and 3-5 recite the graphite material comprises graphite and a component or material other than graphite. Applicant believes this is perfectly clear as the claim recites "comprises" which is open language and can be read as "includes". Thus, the claim reads the graphite material includes both graphite and another material. This is perfectly clear, as it describes the graphite material in clear and concise terms, as required by law. Simply because the material is part graphite

does not make the claim, or the description of the material, unclear. This is similar to claiming any alloy but reciting its most common component as an adjective describing it (for example, aluminum alloy). Applicant would agree if the only description was that the material IS graphite, instead it recites a "graphite material" and then clearly describes that material.

The claims have been amended to remove product by process language.

#### Rejections under 35 U.S.C. § 102/103(a)

Applicants respectfully traverse and, for the following reasons, requests reconsideration and withdrawal of these rejections. Claims 1, 3-5 were rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by, and alternatively unpatentable over Hayashi et al. (Japanese Patent 10-334915).

To anticipate a claim, a reference must teach, expressly or inherently, each and every element required by the claim as interpreted by one of ordinary skill in the art. MPEP § 2131 and 35 USC 102.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations; there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and there must be a reasonable expectation of success. MPEP § 2143. Further, the Federal Circuit has recently held that most inventions arise from a combination of old elements and each element may often be found in the prior art. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *In re Kahn* 441 F.3d 977 (Fed. Cir 2006).

As the Examiner has cited no reference that anticipates the weight reduction limitation present in the instant claims, Applicant believes the claims should be allowed as currently written.


### CONCLUSION

Applicant respectfully requests withdrawal of the rejections and believes that the claims as presented represent allowable subject matter. If the Examiner desires, applicant welcomes a telephone interview to expedite prosecution and is available at the telephone number below.

Applicant believes there is no fee due at this time. However, the Commissioner is hereby authorized to deduct any deficiency or credit any overpayment to Deposit Account No. 19-3140.

Respectfully submitted,

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